

## REMARKS

Claims 1-18 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejection in view of the amendments and remarks contained herein.

### REJECTION UNDER 35 U.S.C. § 103

Claims 1 and 3-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leibach (U.S. Pat. No. 6,250,615) in view of Fukahori et al (U.S. Pat. No. 4,761,925). This rejection is respectfully traversed.

The Examiner alleges that the claimed invention is obvious because Leibach teaches a device that closely resembles the claimed hydro-mount, but does not teach a protective coating. Nevertheless, the Examiner alleges that it is notoriously well known in the art to bond a protective elastomeric layer to a spring element to increase its resistance to the corrosive effects of a particular environment or to alter the spring constant thereof. In support of this allegation, the Examiner relies on Fukahori which teaches an anti-seismic rubber bearing that includes a protective coating. In view of Fukahori's teaching of a protective coating, the Examiner alleges that it would have been obvious to apply a protective coating to the rubber spring element of Leibach for increased resistance to cracking and/or protection from the environment. Applicants, however, respectfully assert that neither Leibach, Fukahori, nor any combination thereof teaches, suggests, or provides motivation to utilize such a structure.

That is, rejections based on 35 U.S.C. §103 must rest on a factual basis. In making such a rejection, the Examiner has the initial duty of supplying the factual basis

and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Werner*, 379 F.2d 1011, 1017; 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although the suggestion more often comes from the teachings of the pertinent references. The range of sources available, however, does not diminish the requirement for actual evidence. What's more, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 999; 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Here, the Examiner has not provided evidence of a suggestion, teaching, or motivation to combine that flows from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. That is, claim 1 recites a hydro-mount comprising a spring element that encloses a work space filled with a damping liquid. The spring element is comprised of a resistant material that is resistant to high temperatures and, on a side facing the work space, is also provided with a protective layer comprising a material that is resistant and impervious to the damping liquid. In contrast, the Leibach reference, in figure 3, merely teaches a structure including a rubber isolator 3 that encloses a work space 8. The Examiner has acknowledged that Leibach is completely silent with respect to a

protective coating formed on a side of the spring element 3 that faces the work space, and is resistant to a damping liquid.

Further, the Leibach reference provides no suggestion or motivation to utilize a spring element including a two layer structure including a resilient material that is resistant to high temperatures, and a protective layer that is impervious a damping liquid. Leibach, rather, teaches in column 4, lines 20-26 that to protect the rubber isolator 3 from high temperatures, the rubber isolator 3 should be shielded by a tension restraint member 14. This is different from the claimed invention which calls for the spring element to be formed of a resilient material that is resistant to high temperatures. Because Leibach teaches a rubber isolator 3 that does not include a dual layer structure, and only teaches that to protect the rubber isolator 3 from high temperatures that the rubber isolator 3 should be shielded by a tension restraint member 14, Applicant respectfully asserts that Leibach does not contain any suggestion or motivation to look to the teachings of Fukahori to provide a dual layer structure that is resistant to high temperatures and is impervious to a damping liquid.

Fukahori also does not contain any teaching or suggestion that would lead one skilled in the art of hydro-mounts to modify the mount of Leibach to include a resilient material that is resistant to high temperatures, as well as include a protective layer disposed on a side of the spring element that faces a work space that is impervious to a damping fluid. This is because Fukahori is directed to an anti-seismic rubber bearing that supports buildings. Moreover, Applicant respectfully asserts that one skilled in the art of hydro-mounts for a vehicle would not be motivated to look to an anti-seismic rubber bearing for a building to solve a problem directed to providing a hydro-mount that

is resistant to high temperatures and impervious to a damping fluid. This is because Fukahori is directed to an art that is completely non-analogous to a hydro-mount for a vehicle. That is, although the bearing of Fukahori is used to dampen vibrations, the vibrations produced during an earthquake are completely non-analogous to the vibrations and high temperatures experienced during operation of a motor vehicle for which the claimed hydro-mount was designed.

What's more, assuming arguendo that one skilled in the art would be motivated to look to Fukahori to provide a hydro-mount that is resistant to high temperatures and impervious to a damping fluid, Applicant respectfully asserts that the proposed combination of Leibach and Fukahori still does not yield the claimed invention. That is, Fukahori in Figure 1 teaches a protective coating 14 that is formed on the outside of the anti-seismic rubber bearing. This protective coating 14, however, is a coating formed of "a special rubber 14 having superior weather resistance." *Fukahori* at column 7, lines 42-43. A coating that is merely resistant to weather contrasts with the claimed invention because the spring element of the claimed invention is formed of a resilient material that is resistant to high temperatures. One skilled in the art of hydromounts would readily acknowledge and appreciate that the temperatures generated in a motor vehicle are much higher than weather-related temperatures. Accordingly, Applicant respectfully asserts that one skilled in the art would not look to modify Leibach with the weather resistant coating of Fukahori because such a coating would not be expected to withstand the high temperatures generated in a motor vehicle.

In view of the foregoing, Applicant respectfully asserts that the Examiner's conclusion of obviousness stems from hindsight reasoning that uses teachings

impermissibly gleaned from the present invention. There is no suggestion in the Leibach reference that a dual layer structure should be utilized to protect the claimed spring element from high temperatures and damping fluid because Leibach teaches that the rubber isolator 3 should merely be shielded by a tension restraint member 14 to protect from high temperatures. Further, to modify the teachings of Leibach with the teachings of Fukahori would merely result in a hydro-mount that is formed with an outer layer formed on an outside of the spring element that is resistant to weather. There is no teaching or suggestion that the rubber coating of Fukahori is resistant to high temperatures, as claimed.

Accordingly, Applicant respectfully asserts that the Examiner has breached his initial duty to supply a factual basis that supports a rejection under 35 U.S.C. §103. Because the Examiner has impermissibly used evidence gleaned from the Applicant's own disclosure in a hindsight reconstruction of the present invention, the claimed invention is not obvious. Applicant, therefore, respectfully requests reconsideration and withdrawal of this rejection.

With respect to dependent claims 9-11, the Examiner alleges that a ratio of a thickness of the spring element to a thickness of the protective layer that amount to at least 2 would have been obvious in order to maximize the wear and fatigue properties of the spring element for a specific application. Notwithstanding, Applicant respectfully asserts that such a configuration would not have been obvious in view of Leibach and Fukahori. More specifically, the modification of Leibach's rubber isolator 3 to include the coating 14 of Fukahori would result in a hydromount having the rubber isolator 3 of Leibach as the claimed protective layer, and the rubber coating 14 of Fukahori as the

claimed spring element. Such a configuration, however, would teach away from the claimed invention.

That is, at paragraph [0017] of the specification of the present invention, it is disclosed that “[t]he lower the thickness of the protective layer, the smaller is the effect of the protective layer on the use properties of the spring element.” In other words, when the thickness of the protective layer is kept low, the spring element will exhibit better spring action. In contrast, the Examiner’s proposed modification of Leibach with the coating of Fukahori would result in a spring element that has poor spring properties because the protective layer would be extremely thick compared to the thickness of the spring element. Because such a configuration teaches away from the claimed invention, Applicants respectfully assert that claims 9-11 would not have been obvious in view of Leibach and Fukahori.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Leibach in view of Fukahori et al as applied to claim 1, above, and further in view of Vernier (U.S. Pat. No. 3,874,646). This rejection is respectfully traversed.

Claim 2 is dependent on independent claim 1, addressed above. Claim 2 is not obvious for at least the same reasons.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

## NEW CLAIMS

New claims 12-18 have been added. These new claims are fully supported by the specification and drawings as originally filed. No new matter has been added. Favorable consideration of these new claims is respectfully requested.

New claim 12 depends from claim 1. New claim 12 is neither anticipated nor obvious for at least the same reasons as stated above.

New claim 13 is directed to an engine mount for a motor vehicle, comprising a support bearing and an end bearing. A spring element connects the support bearing and the end bearing, and the spring element encloses a work space that is filled with a damping fluid. The spring element includes a dual layer structure composed of an outer layer and an inner layer, wherein the outer layer is formed of a material resistant to high temperatures generated by the motor vehicle, and the inner layer is formed of a material that is impervious to the damping fluid. As stated above under the rejection under 35 U.S.C. § 103(a) in view of Leibach and Fukahori, such a configuration is not obvious. Accordingly, Applicants respectfully assert that new claims 13-18 are neither anticipated nor obvious, and in condition for allowance.

## CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office

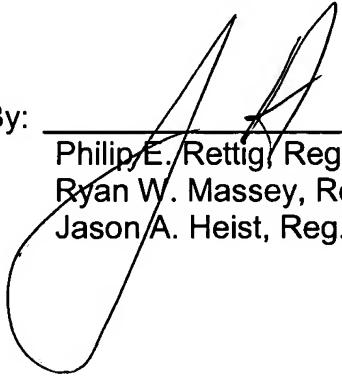
Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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